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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,588	08/01/2003	Ben Burdsall	10022/558	5012

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EXAMINER

SHAPIRO, LEONID

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/632,588	Applicant(s) BURDSALL ET AL.	
	Examiner Leonid Shapiro	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/01/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-20 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 9 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 8 and 10-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin (US Patent No. 6,603,464 B1) in view of Ornato et al. (US Patent No. 4,457,312) and Segawa et al. (Pub.: US 2004/0019879 A1).

As to claim 1, Rabin teaches a method for digitally processing information to be written on an observation form (See Col. 1, Lines 11-15), said form being preprinted with at least one blank chart (TSA) having at least one line and several columns, said form being also preprinted with a pattern adapted to cooperate with a digital pen and a computerized localization system for determining the position of the pen (See Figs. 1, 3, items 10, 13, Col. 3, Lines 2-10 and from Col. 3, Line 64 to Col. 4, Line 65), comprising the steps of:

using a pen having a writing tip and a digital tip (See Fig. 2, items 16, 18, 20, Col. 3, Lines 11-29);

filling in data in one column at a time (See Fig. 3, items 32, 34, Col. 10, Lines 10-28);

reproducing said data in the computerized localization system (See Fig. 3, item 18, Col. 10, Lines 40-44).

Rabin does disclose each column corresponding to a determined printed time.

Ornato et al. teaches each column corresponding to a determined printed time (See Fig. 2, items 1-10, Col. 5, Lines 2-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Ornato et al. teaching into Rabin system in order to permit easy and quick recording of events and their correlation with other recorded information (See Col. 2, Lines 26-30 in the Ornato et al. reference).

Rabin and Ornato et al. do not disclose comparing said recording time with the localized printed time of said data, so as to detect any inconsistency between the recording time and the printed time.

Segawa et al. teaches comparing said recording time with the localized printed time of said data, so as to detect any inconsistency between the recording time and the printed time (See paragraph 0076).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Segawa et al. teaching into Rabin and Ornato et al. system in order to exclusively control write request (See paragraph 0021 in the Segawa et al. reference).

As to claim 7, Rabin teaches a computerized system for processing information to be written on an observation form (See Col. 1, Lines 11-15), said form being preprinted with at least one blank chart (TSA) having at least one line and several columns, said form being also preprinted with a pattern adapted to cooperate with a digital pen and a computerized localization system for determining the position of the

Art Unit: 2629

pen (See Figs. 1, 3, items 10, 13, Col. 3, Lines 2-10 and from Col. 3, Line 64 to Col. 4, Line 65), comprising:

at least one pen having a writing tip and a digital tip (See Fig. 2, items 16, 18, 20, Col. 3, Lines 11-29);

means for registering data in one column at a time (See Fig. 3, items 32, 34, Col. 10, Lines 10-28).

Rabin does not disclose each column corresponding to a determined printed time and means for registering along with data hand written in one column at one time, its recording time and means for collecting and storing data and recording time.

Ornato et al. teaches each column corresponding to a determined printed time and means for registering along with data hand written in one column at one time, its recording time and means for collecting and storing data and recording time (See Fig. 2, items 1-10, Col. 5, Lines 2-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Ornato et al. teaching into Rabin system in order to permit easy and quick recording of events and their correlation with other recorded information (See Col. 2, Lines 26-30 in the Ornato et al. reference).

Rabin and Ornato et al. do not comparing said recording time with the localized printed time of said data, so as to detect any inconsistency between the recording time and the printed time.

Segawa et al. teaches comparing said recording time with the localized printed time of said data, so as to detect any inconsistency between the recording time and the printed time (See paragraph 0076).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Segawa et al. teaching into Rabin and Ornato et al. system in order to exclusively control write request (See paragraph 0021 in the Segawa et al. reference).

As to claim 3, Segawa et al. teaches generating alert if a difference between said localized printed time and said recording time exceeds a predetermined threshold (See Paragraph 0076).

As to claim 9, Segawa et al. teaches comparing said recording time with the localized printed time of said data, so as to detect an eventual miss of the prescript action (See paragraph 0076).

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segawa et al., Rabin and Ornato et al. as applied to claim 1 above, and further in view of Sekura et al. (US patent No. 6,198,383 B1).

Segawa et al. teaches comparing said recording time with the localized printed time of said data, so as to detect any inconsistency between the recording time and the printed time (See paragraph 0076).

Segawa et al., Rabin and Ornato et al. do not disclose detection of an eventual miss of prescript action.

Sekura et al. teaches detection of an eventual miss of prescript action (See Col. 19, Lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Sekura et al. teaching into Rabin, Segawa et al. and Ornato et al. system in order to provide prescription compliance device (See Col. 1, Line 47-50 in the Sekura et al. reference).

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segawa et al., Rabin and Ornato et al. as applied to claim 1 above, and further in view of Albaum et al. (US patent No. 5,758,095).

Segawa et al., Rabin and Ornato et al. do not disclose an action is a drug administration.

Albaum et al. teaches an action is a drug administration (See Col. 6, Lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Albaum et al. teaching into Rabin, Segawa et al. and Ornato et al. system in order to provide prescription ordering device (See Col. 2, Line 65-67 in the Albaum et al. reference).

Response to Arguments

4. Applicant's arguments filed 02.27.06 have been fully considered but they are not persuasive:

On page 7, last paragraph of Remarks, Applicant's stated that Segawa et al. comparing two recorded times and that the recorded times bear no resemblance to the printed time. However, recorded time is printed or displayed on the monitor for respective fields and recorded from the memory.

On page 9, 2nd paragraph of Remarks, Applicant's stated that Rabin does not disclosed means for registering of claim 7 and Ornato et al. does not disclose a digital pen. However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On the same, the same paragraph, Applicant's stated that Ornato et al. directed toward illuminated clipboards. However, "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures.").

Allowable Subject Matter

5. Claim 14-20 are allowed.

Relative to claim 14 the major difference between the teaching of the prior art of record (Segawa et al., Rabin and Ornato et al.) and the instant invention is that prescript time is automatically deduced from another chart.

Claims 15-20 depend on claim 14.

6. Claims 4, 6, 8, 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Relative to claims 4, 10 the major difference between the teaching of the prior art of record (Segawa et al., Rabin and Ornato et al.) and the instant invention is that prescript time is automatically deduced from another chart.

Claims 11-13 depend on claim 10.

Relative to claims 6, 8 the major difference between the teaching of the prior art of record (Segawa et al., Rabin and Ornato et al.) and the instant invention is that collecting information on drug administration from several observation forms for drug stock evaluation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Telephone Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 571-272-7683. The examiner can normally be reached on 8 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LS
05.05.06



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